

REMARKS

Claims 1-3, 6-7 and 9-13 are pending in the present application. By this Amendment, previously presented claims 1 and 6 have been amended; previously presented claim 4 has been canceled; and new claims 12-13 have been added. Applicant respectfully requests reconsideration of the present claims in view of the foregoing amendments and the following remarks.

I. Formal Matters:

Information Disclosure Statement

Applicant submits herewith a supplemental Information Disclosure Statement (IDS) citing (1) three documents that were recently cited in a corresponding foreign application, and (2) the references previously cited in Applicant's September 27, 2004 IDS.

If another supplemental IDS is necessary to cite one or more references disclosed in Applicant's specification, Applicant will submit another supplemental IDS in the upcoming weeks prior to further action in this case.

Co-Pending Applications

Applicant is not aware of any co-pending application(s) that is "material" to examination of the present application.

Rejection of Previously Presented Claims 1-4, 6-7 and 9-11 Under 35 U.S.C. §112, First Paragraph

Previously presented claims 1-4, 6-7 and 9-11 were rejected under 35 U.S.C. §112, first paragraph, as not meeting the enablement requirement. This rejection is respectfully traversed.

Although Applicant maintains the position that previously presented claims 1-4, 6-7 and 9-11 met the enablement requirements of 35 U.S.C. § 112, first paragraph, Applicant has further amended independent claim 1, as shown above, to limit Het groups to pyrazolyl, pyrrolyl, thiophenyl, furyl, thiazolyl, isothiazolyl, oxazolyl, isoxazolyl, triazolyl, pyridinyl, pyrazinyl,

pyrimidinyl, pyridazinyl, 5,6-dihdropyrane or 5,6-dihydro-1,4-oxathiinyl, each being substituted by groups R⁷, R⁸ and R⁹.

The above-noted substituted heterocyclic groups are well known to those skilled in the art. Further, methods of providing common substituents R⁷, R⁸ and R⁹ (e.g., hydrogen, halogen, C₁₋₃ alkyl, C₁₋₃ haloalkyl, C₁₋₃alkoxy(C₁₋₃)alkyl or cyano) on a given heterocyclic group are also well known to those skilled in the art.

Applicant's original specification clearly describes multi-step reactions for forming intermediate compounds of formula (II) used to form compounds of formula (I) recited in independent claim 1. A first three-step reaction for forming intermediate compounds of formula (II) is disclosed on page 23, lines 4-16. A second three-step reaction for forming intermediate compounds of formula (II) is disclosed from page 23, line 17 to page 24, line 5. From page 24, line 6 to page 25, line 31, Applicant's original specification discloses twenty-five references that detail possible process parameters for each of steps 1 to 3 within the first and second multi-step reactions for forming intermediate compounds of formula (II).

Beginning on page 26, Applicant's original specification clearly describes the reaction mechanism for forming compounds of formula (I), namely, by reacting a compound of the formula Het-C(=O)-R*, where Het is as defined above and R* is halogen, hydroxy or C₁₋₆alkoxy, preferably chloro, with a compound of formula (II) formed via the first or second multi-step reactions described on pages 23-24 of Applicant's original specification. Compounds having formula Het-C(=O)-R* may be formed using conventional reaction steps known to those skilled in the art.

Applicant respectfully submits that one skilled in the art, given Applicant's original specification describing (i) the above-mentioned reactions steps for forming compounds of formula (I), (ii) numerous exemplary compounds shown in Tables 1-17 on pages 5-23, and (iii) example reaction steps for forming exemplary compounds in Examples 1-6, would have understood how to make and use compounds of formula (I) recited in current claims 1-3, 6-7 and 9-11 without undue or unreasonable experimentation. Instead, one skilled in the art, given Applicant's original specification coupled with information already known to one skilled in the

art, would simply utilize predictable and routine method steps, as discussed above, to make and use compounds of formula (I).

Applicant further submits that a thorough analysis of all of the factors discussed by the Court in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988), leads to the same conclusion, namely, that Applicant's original specification provides an enabling disclosure to one skilled in the art regarding how to make and use compounds of formula (I) without undue or unreasonable experimentation. Applicant respectfully submits that, in the present case, the following factors weight heavily in favor of a final determination of enablement: (1) Applicant's original specification provides considerable direction and guidance to one skilled in the art (e.g., a broad scope of exemplary compounds, numerous working examples, a broad scope of compounds showing efficacy when used in a method of controlling or preventing infestation of cultivated plants by phytopathogenic microorganisms, etc.), (2) there existed a high level of skill in the art of chemical compound synthesis at the time the application was filed; and (3) all of the methods needed to form compounds of formula (I), as well as practice the present invention were either (i) well known to those skilled in the art or (ii) are adequately described in Applicant's original specification.

For at least the reasons provided above, Applicant respectfully submits that current claims 1-3, 6-7 and 9-11 meet the enablement requirements of 35 U.S.C. § 112, first paragraph. Accordingly, withdrawal of the rejection of current claims 1-3, 6-7 and 9-11 under 35 U.S.C. § 112, first paragraph is respectfully requested.

Provisional Rejection of Previously Presented Claims 1-4, 6-7 and 9-11 - Non-Statutory Double-Patenting

Previously presented claims 1-4, 6-7 and 9-11 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (i) claims 1-8 and 10 of co-pending U.S. Patent Application Serial No. 10/588,293, and (ii) claims 1-7 of co-pending U.S. Patent Application Serial No. 10/579,033. These rejections are respectfully traversed.

It appears from a review of USPTO assignment records that (i) U.S. Patent

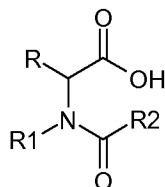
Application Serial No. 10/588,293 and (ii) U.S. Patent Application Serial No. 10/579,033 are assigned to Bayer Cropscience AG, not Syngenta, the owner of the present application. Accordingly, withdrawal of this rejection is respectfully requested.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 1-4, 6-7 and 9-11 Under 35 U.S.C. §103(a) In View of U.S. Patent Application Publication No. 2001/0031890 (Riermeier)

Previously presented claims 1-4, 6-7 and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent Application Publication No. 2001/0031890 to Riermeier et al. (hereinafter, "Riermeier"). This rejection is respectfully traversed.

The teaching of Riermeier is directed to processes for racemization of enantiomerically pure compounds having the formula below:



wherein each of R, R1, and R2 is independently selected from a hydrogen and/or alkyl, alkenyl, alkynyl, aryl and/or heteroaryl radical, where alkyl can be an aliphatic carbon group having 1 to 18 carbon atoms, which can be linear, branched and/or alternatively cyclic, and alkenyl or alkynyl is a mono- or polyunsaturated aliphatic group having 2 to 18 carbon atoms, which can be branched or nonbranched, and aryl is a five-, six- or seven-membered aromatic ring, where this ring can be fused and can contain 0 to 3 heteroatoms such as N, O, S, comprising 4 to 14 carbon atoms, and in this case the alkyl and the aryl group can optionally carry up to six further substituents which independently of one another are hydrogen, alkyl, O-alkyl, OCO-alkyl, O-aryl, aryl, fluorine, chlorine, bromine, iodine, OH, CF₃, NO₂, NO, Sialkyl₃, CN, COOH, CHO, SO₃H, NH₂, NH-alkyl, N-alkyl₂, PO-alkyl₂, SO₂-alkyl, SO-alkyl, NHCO-alkyl, CONH₂, CO-alkyl, COO-alkyl, NHCOH, NHCOO-alkyl, CO-aryl, COO-aryl, POaryl₂, PO₃H₂, PO(O-alkyl)₂, or SO₃-alkyl.

In order for one skilled in the art, given the teaching of Riermeier, to come up with compounds similar to Applicant's claimed compounds, one skilled in the art would need to

(1) select R2 to be a heterocyclic group as recited in claim 1; and (2) select R1 to be a phenyl group substituted at the ortho position with a Si-alkyl₃ substituent. Each of these specific selections would need to be made from the long list of alternatives described above. Applicant submits that the teaching of Riermeier does not suggest to one skilled in the art to make the above selections.

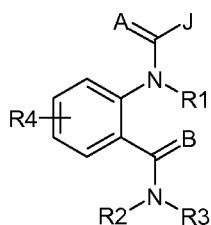
Moreover, even if one skilled in the art were to make the above-mentioned selections, one skilled in the art would still not arrive at the compounds of Applicant's claimed invention. For example, the resulting structure would not comprise a Het group as recited in Applicant's claim 1. Further, the resulting structure would also comprise the moiety -CRCOOH, which is not present in Applicant's compounds of formula (I). See, for example, the definition of R¹ as recited in Applicant's independent claim 1.

For at least the reasons given above, it is respectfully submitted that the teaching of Riermeier fails to make obvious Applicant's claimed invention as embodied in independent claim 1. Since claims 2-3, 6-7 and 9-11 depend from independent claim 1 and recite further claim features, the teaching of Riermeier also fails to make obvious Applicant's claimed invention as embodied in dependent claims 2-3, 6-7 and 9-11 (previously presented claim 4 has been canceled). Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of Previously Presented Claims 1-4, 6-7 and 9-11 Under 35 U.S.C. §103(a) In View of U.S. Patent No. 6,747,047 (Lahm)

Previously presented claims 1-4, 6-7 and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent No. 6,747,047 issued to Lahm et al. (hereinafter, "Lahm"). This rejection is respectfully traversed.

The teaching of Lahm is directed to compounds having the generic formula below:



wherein A, B, J and R1-R4 are as defined in Lahm from column 2, line 14 to column 4, line 30.

The teaching of Lahm fails to disclose, teach or suggest Applicant's compounds of formula (I) as recited in independent claim 1. In particular, the teaching of Lahm requires the disclosed compounds to comprise a moiety corresponding to $-C(B)N(R_2)R_3$. Applicant's compounds of formula (I) as recited in independent claim 1 do not include a moiety corresponding to $-C(B)N(R_2)R_3$.

There is no teaching or suggestion in the teaching of Lahm that would have motivated one of skill in the art to provide compounds that do not include the $-C(B)N(R_2)R_3$ group. To suggest otherwise would ignore the teaching of Lahm.

The March 19, 2009 Office Action indicates on page 14 that a specific compound that does not contain the $-C(B)CH(R_2)R_3$ group has been disclosed by the prior art. However, it is not clear that the teaching of Lahm actually discloses this compound. As discussed above, the teaching of Lahm appears to require the moiety corresponding to $-C(B)N(R_2)R_3$.

For at least the reasons given above, it is respectfully submitted that the teaching of Lahm fails to make obvious Applicant's claimed invention as embodied in independent claim 1. Since claims 2-3, 6-7 and 9-11 depend from independent claim 1 and recite further claim features, the teaching of Lahm also fails to make obvious Applicant's claimed invention as embodied in dependent claims 2-3, 6-7 and 9-11 (previously presented claim 4 has been canceled). Accordingly, withdrawal of this rejection is respectfully requested.

III. New Claims 12-13:

New claims 12-13 are directed to various embodiments of Applicant's present invention. New claims 12-13 depend from independent claim 1 and recite additional claim features.

Support for new claims 12-13 may be found in at least the following locations of Applicant's original specification: page 27, lines 17-20.

For at least the reasons given above, Applicant respectfully submits that new claims 12-13 are in condition for allowable.

IV. Specific Request on Page 17 of March 19, 2009 Office Action:

The March 19, 2009 Office Action specifically requests that Applicant identify any prior art that has been excluded from the claimed invention due to the claim feature “where at least one of R⁷, R⁸ and R⁹ is not hydrogen.” Applicant is not aware of any specific prior art that is excluded from the claimed invention by this claim language. Applicant is simply using this language to recite that at least one of R⁷, R⁸ and R⁹ is not a hydrogen atom.

V. Conclusion:

For at least the reasons given above, Applicant submits that claims 1-3, 6-7 and 9-13 define patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims.

Should Examiner Qazi believe that further action is necessary to place the application in better condition for allowance, Examiner Qazi is respectfully requested to contact Applicant’s representative at the telephone number listed below.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

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W&K Matter No.: 10075.0038USWO
Syngenta Docket No.: 50702